

REMARKS

In the Final Office Action that was mailed on April 28, 2005, claims 1, 3, 7-10, and 14 were rejected under 35 U.S.C. § 102(e) as being anticipated by O'Brien; claims 2, 11, and 12-13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over O'Brien in view of Biegel; and claims 4-6 and 13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over O'Brien in view of Biegel and Treu. The foregoing rejections are respectfully traversed. Claim 15 has been added.

Claims 1-15 are pending in the subject application, of which claims 1 and 9-11 are independent claims.

Amendments to the Claims:

Independent claims 1 and 9-11 are amended herein to recite that the text string is "created by a software developer." Care has been exercised to avoid the introduction of new matter.

Support for the amendments to claims 1 and 9-11 may be found in the Specification, for example, at page 4, line 12, page 10, lines 15-17, and page 11, lines 16-22.

Rejections of the Claims:

Differences Between the Claimed Invention and the Cited References:

Independent claims 1 and 9-11 of the subject application (as amended herein) recite removing a text string that is "created by a software developer" from the program. O'Brien discusses "remov[ing] information from the source code 60 such as comments that may have been added by the source code's programmer." (O'Brien, col. 12, lines 3-5). However, as argued previously, "[w]hen O'Brien's C preprocessor 66a removes the programmer's comments, it does not replace the comments with anything, leaving the program devoid of any means of

referring back to the comments if later debugging is required.” (January 4, 2005 Amendment, p. 12). In contrast, independent claims 1 and 9-11 of the subject application recite coding or assigning and including a unique tag to the text string, creating an index or decoding file mapping the unique tags to the text strings. Thus, with the present invention, upon debugging the program, the programmer is able to refer to his comments via the indexed unique tags, whereas in O’Brien, nothing allows the programmer to refer back to the removed comments. Clearly, independent claims 1 and 9-11 are patentably distinguishable over the cited references. Dependent claims 2-8 and 12-14 are allowable, for example, based in part in their dependency from one of claims 1 and 9-11.

Continuing Lack of Motivation to Combine the References:

In response to the Applicant’s argument that the October 21, 2004 Office Action failed to set forth the requisite motivation to combine the references for purposes of a *prima facie* case of obviousness, the April 28, 2005 Final Office Action stated that “[s]ince all O’Brien, Biegel, and Treu try to solve the same problem as the current applicant does, the Examiner sees a very strong motivation to combine any of their inventions together.” (4-48-2005 Office Action, p. 4) (emphasis in original). The Office Action discusses the Specification of the subject application and uses it to compare the problems to be solved to the cited references. However, the Office Action may not rely on the Specification to support the motivation to combine the references. In particular, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant’s disclosure. MPEP § 2143 (citing In re Vaeck, 20 USPQ2d 1438 (Fed. Cir. 1991)). While the Applicant recognizes that the Office Action cited to the Specification in an attempt to show similarity between the problems to be solved, the fact remains that the Office Action impermissibly relied on the applicant’s disclosure to support the motivation to combine the references. Therefore, the combinations remain improper and should be withdrawn.

Withdrawal of the foregoing rejections is respectfully requested. The remarks herein are to be interpreted only in the context of the specific claims for which they are presented.

There being no further objections or rejections, it is submitted that the application is in condition for allowance, which action is courteously requested. Finally, if there are any formal matters remaining after this response, the examiner is requested to telephone the undersigned to attend to these matters. If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-2112.

Respectfully submitted,

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Date: _____

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By: _____

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